UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,359	11/13/2003	Yie-Hwa Chang	48483-103186	1306

7590 09/25/2006

Kathryn J. Doty
Polsinelli Shalton Welte Suelthaus PC
Suite 1100
100 S. Fourth Street
St. Louis, MO 63102

EXAMINER	
DAVIS, MINH TAM B	

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/712,359	CHANG ET AL.	
	Examiner	Art Unit	
	MINH-TAM DAVIS	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 May 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Claims 1, 19 are linking claims, linking inventions 1-20. Claim 9 is a linking claim, linking inventions 9-20. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 9, 19. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP 804.01.

Groups 1-8. Claims 1-8, 19-20, drawn to a method for modulating cell proliferation, using a variant MetAP2 polypeptide of SEQ ID NO: 6, 7, 8 or 16, and a translation domain of SEQ ID NO:1, 2, 3, 15, classified in class 514, subclass 2. A method using each combination of a variant MetAP2 polypeptide of SEQ ID NO: 6, 7, 8 or 16, and a translation domain of SEQ ID NO:1, 2, 3, 15 constitutes a single, distinct invention.

Groups 9-20. Claims 1-20, drawn to a method for modulating cell proliferation, using a MetAP2 polynucleotide encoding a variant MetAP2 polypeptide of SEQ ID NO: 6, 7, 8 or 16, and a translation domain of SEQ ID NO:1, 2, 3, 15, or a MetAP2 polynucleotide of SEQ ID NO: 9,10, 11, or 18, classified in class 514, subclass 44. A method using each polynucleotide encoding each combination of a variant MetAP2 polypeptide of SEQ ID NO: 6, 7, 8 or 16, and a translation domain of SEQ ID NO:1, 2, 3, 15, or each of SEQ ID NO: 9,10, 11, or 18 constitutes a single, distinct invention.

This application contains claims directed to the following patentably distinct species:

For groups 1-20, the species of SEQ ID NO: 6, 7, 8 or 16 having substitution at a single Xaa position, or at any one combination of different Xaa positions.

The inventions are distinct, each from each other because of the following reasons:

The inventions of Groups 1-20 are materially distinct methods. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, and different effects (MPEP § 806.04, MPEP § 808.01). The instant specification does not disclose that these methods would be used together. The inventions of Groups 1-20 are materially distinct methods, which differ at least in method steps, reagents and/or dosages and/or schedules used, response variables, and criteria for success. The different products used in the different methods are distinct, because they are different polynucleotides or polypeptides with distinct structure and would produce different effects. Thus, each group is unrelated as they comprise distinct steps and utilize different products, which

demonstrates that each method has different mode of operation. For these reasons the Inventions 1-20 are patentably distinct.

Furthermore, the distinct steps and products require separate and distinct searches. The examination of all groups would require different searches in the U.S. patent shoes and the scientific literature and would require the consideration of different patentability issues. There may be journal articles devoted solely to a method for treating cancer using a polypeptide, which would not have described methods of treating cancer using another polypeptide, or a polynucleotide, or vice versa. As such, it would be burdensome to search the inventions of Groups 1-20 together.

Because these inventions are distinct for the reason given above and have acquired a separate status in the art, and because the searches for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Applicants are required under 35 USC 121 to elect a single disclosed group for prosecution on the merits to which the claims shall be restricted. Applicant is further required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 9, 19 are generic.

Applicant is advised that a reply to this requirement must include **an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MINH-TAM DAVIS whose telephone number is 571-272-0830. The examiner can normally be reached on 9:00 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY SIEW can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JEFFREY SIEW
SUPERVISORY PATENT EXAMINER

MINH TAM DAVIS

September 14, 2006